

REMARKS

Claims 86-88 are new. Support for the new claims can be found throughout the specification, e.g., at page 7, line 10; page 16, line 16; and page 17, line 27. No new matter has been added.

Claims 70-81 have been cancelled without prejudice or disclaimer of the subject matter thereof. Claims 1-69 and 82 - 88 are now pending in the application.

Applicants note with appreciation the Examiner's indication that certain subject matter is free of the art of record.

Rejection of claims under 35 U.S.C. 102(b)/103(a)

In the Office Action, claims 1-19, 37-40 and 83 have been rejected under 35 U.S.C. 102(b) as anticipated by, or alternatively under 35 U.S.C. 103(a) as obvious over Barnes et al., U.S. Patent 5,001,184 ("the '184 patent" or "Barnes"). Applicants respectfully traverse the rejection.

The Examiner has stated that the '184 patent discloses "reinforced composite materials having a thermoplastic matrix . . . and at least 30% by volume of reinforcing filaments, at least 25% by volume being pitch based graphite fibers . . . it is not clear how applicants' graphitized pitch-based carbon fibers differ from the fibers disclosed in Barnes." The Examiner thus appears to assert that the fibers of Barnes inherently meet the limitations of the pending claims. This rejection is traversed.

The Barnes patent discloses certain compositions which can include, *inter alia*, certain pitch based carbon fibers. Barnes provides that the materials can be used, e.g., for "aerospace applications" (Barnes, Col. 1, lines 48-56). The Barnes patent discloses, e.g., in Example 1, the use of certain carbon fibers which are fed into heated rolls as a powdered resin is added. The resulting material includes continuous collimated carbon fibers in a resin base.

In contrast, the present invention is directed to an article having a bearing surface in which the distribution of the additive in the article can be homogeneous (see, e.g., new claim 87). The articles of the invention have improved tribological characteristics, and can be used in applications where improved wear characteristics are desirable, e.g., in sleeve bearings (see, e.g., new claim 88). Applicants respectfully urge that the disclosure of Barnes does not and cannot anticipate the pending claims.

Moreover, the properties of articles produced according the Barnes method would be expected to be quite different from the properties of the presently-claimed articles. For example, the articles of Barnes would not be expected to have the properties of articles using the preferred graphitized pitch-based fibers according to this invention. For example, contrary to the Examiner's assertion, the fibers specifically disclosed by Barnes would not be expected to have the properties recited in, e.g., claim 19 of the present

application, as the Barnes fibers are likely to have, *inter alia*, a lower tensile modulus than the fibers of claim 19. Similarly, an article according to Barnes would be unlikely to have the wear factor recited in pending claim 37, at least because the materials produced according to Barnes are directional (according to the orientation of the fibers within the article) and therefore would be expected to exhibit uneven wear.

It is well-established that a claim is anticipated only if each and every element or feature of a claim is expressly or inherently described in a single prior art reference. See, e.g., MPEP 2131. For a reference to inherently disclose a feature not expressly disclosed, extrinsic evidence can be used to supply the missing feature only if the extrinsic evidence “make[s] clear that the missing descriptive matter is *necessarily present* in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. Inherency, however, may not be established by probabilities or possibilities.” MPEP 2112(IV), citing *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted) (emphasis added).

Applicants respectfully contend that, however, that the Office Action has not provided any extrinsic evidence that the materials of Barnes include *all the features* of the claimed invention, or that persons of ordinary skill in the art would recognize that *all the features* of the claimed invention are present in the Barnes reference. See, e.g., MPEP §2131.01, Heading III citing *Continental Can Co. USA v. Monsanto Co.* 20 USPQ2d 1746 (Fed. Cir. 1991).

In the absence of such evidence, Applicants respectfully contend that the Examiner has not met the burden of establishing that the Barnes reference discloses, either explicitly or inherently, the claimed articles or compositions. Nor has the Examiner pointed to a sufficient teaching or suggestion in Barnes so as to render obvious the pending claims.

Reconsideration and withdrawal of the rejection is proper and the same is requested.

Double Patenting Rejection of Claims

Claims 1-69 and 82-85 stand provisionally rejected under the judicially-created doctrine of obviousness-type double patenting over the claims of co-pending, co-owned application 09/917,199. Applicants note that the co-pending application has not yet issued as a patent. Applicants traverse the rejection. However, should the rejection not be withdrawn, Applicants will consider filing a terminal disclaimer, if appropriate, to obviate this rejection upon indication that all claims are otherwise allowable.

Conclusion

It is respectfully submitted that the subject application is in a condition for allowance. Early and favorable action is requested.

The undersigned requests any extension of time necessary for response. If for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge Deposit Account No. **04-1105**, under Reference No. 55531 (45676), Customer No. 21874.

Respectfully submitted,

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